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| REINHART BOERNER VAN DEUREN S.C. ATTN: LINDA KASULKE, DOCKET COORDINATOR 1000 NORTH WATER STREET SUITE 2100 MILWAUKEE, WI 53202 | | | POINVIL, FRANTZY | |
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

MAILED

Application Number: 09/277,189
Filing Date: March 26, 1999
Appellant(s): MCLAUGHLIN ET AL.

DEC 28 2006

GROUP 3600

Leslie S. Miller
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 9/19/2006 appealing from the Office action mailed 10/20/2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| | | |
|-----------|----------------|-----------|
| 5,963,925 | Kolling et al. | 5,963,925 |
| 6,097,834 | Krouse et al. | 6,097,834 |
| 5,191,525 | LeBrun et al. | 5,191,525 |

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(9) Grounds of Rejection

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-30 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Kolling (US Patent No. 5,963,925) in view of Krouse et al (US Patent No. 6,097,834).

Appellant's representative agrees that the Kolling et al. patent is an electronic bill presentment system which is only capable of accepting electronic billing information from billers and presenting it electronically to consumers.

The Appellant however indicates that the Kolling et al. reference simply does not work with paper bills, and does not use paper statements or invoices in any way; in fact, there is not a single word in the entire Kolling et al. reference which deals with the issue of paper bills.

Rather, the Kolling et al. reference "replaces the preparation and mailing of paper statements and invoices from a biller with electronic delivery." Abstract, lines 1-2 (emphasis added). The electronic statements, when displayed on the consumer's computer, have the same look as paper bills would have had (or formerly had).

The Examiner agrees with appellant's assertion of the Kolling et al.'s reference.

From this assertion, it should be noted that the allowing, notifying and receiving functions are taught by Kolling with the exception that Kolling et al do not deal with the

presentment of paper bills. As per the features of receiving paper bills and scanning the paper bills, the Examiner has turned to Krouse et al.

Appellant's representative then indicates that:

The Krouse et al. reference is a walk-in bill payment system in which a customer brings a paper bill and physically walks into a location having a terminal for the walk-in bill payment system. As such, it is a completely manual bill payment system which is incapable of presenting bills to customers, and which is electronic only in that payment to the biller is made by the walk-in bill payment system through the ACH/EFT system. The customer must bring a paper bill to the facility.

Appellant's representative then states that the Kolling et al's and Krouse et al's references are unrelated and cannot be combined.

The Examiner respectfully disagrees with the appellant's assertion.

Krouse et al are directed to the processing of a financial transaction by placing a financial document to be processed into a scanner and obtaining an electronic version of the financial document using an optical character reader (OCR) (see column 12, lines 12-65). Information of the financial document is extracted (column 16, lines 52-59) and are later transmitted and stored to an ACH/EFT request generator (column 16, lines 60-66). The generator can also display the extracted information to a user or customer. See column 16, line 66 to column 17, line 47).

Steps of manipulating financial documents from paper to electronic forms are taught by Krouse et al. Since bills may be accepted in any ways or manner, it would have been obvious to one of ordinary skill in the art when using the system of Kolling et al to also accept paper

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checks from billers by applying the system of Krouse et al. therein in order to handle paper bills from billers who are not yet devoted to transmit electronic bills. The motivation would have been to allow many types of billers to use the combined system of Kolling et al and Krouse et al thereby providing better customer service to their clients.

As per claims 1 and 16, Kolling teaches a system and method for presenting an electronic bill or statement to a customer who has subscribed to receive electronic bills from a biller. See the abstract and column 12, lines 36-42. The system further comprises:

Allowing a customer to subscribe to a bill presentment system for receiving electronic-based (column 12, lines 36-42 and column 4, line 63 to column 5, line16) of Kolling.

notifying a plurality of billers that said customer has subscribed to said bill presentment system, said billers including electronic-based billers (column 4, line 63 to column 5, line 16 of Kolling);

receiving at least one electronic bill for said customer from at least one of said billers (column 7, lines 25-57 of Kolling);

identifying the type of bill (is done using a template library. Also, different billers would send different bills and different types of bills for different customers) column 8, lines52-62 and column 9, lines28-64 of Kolling)

extracting billing information from said electronic image information wherein the billing information is extracted using a predefined template (see column 9, line 28 to column 10, line 21 and column 11, lines 43-55 of Kolling);

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presenting said at least one electronic bill to said customer (column 13, lines 334-59 of Kolling).

Kolling does not specifically teach receiving paper bills for conversion to electronic bills. Thus, Kolling does not specifically teach the steps of: receiving at least one paper bill for said customer from at least one of said billers; identifying the contents of said paper bill; scanning said at least one paper bill received for said customer to generate electronic image information; and validating the extracted billing information generated from said scanned paper bill.

As per these limitations the Examiner notes that transmitting or mailing paper bills to Kolling for further processing and presenting to a customer in an electronic format would have been obvious to one of ordinary skill in the art to do at the time of the invention. Nothing in Kolling prevents Kolling from accepting paper bills for conversion to electronic formats. A biller in the system of Kolling may not have the capability of electronically transmit their electronic bills to the system of Kolling for further processing by Kolling. Thus, transmitting paper bills to the system of Kolling would have been readily acceptable through the regular mail system.

In so doing, Kolling would have scanned the received paper bills, do further image processing and cleaning the scanned paper bills which would have then converted in an electronic format. The extracted steps would have also been done for indexing and record keeping purposes.

These steps are well known in the art of image processing and analysis of scanned financial documents. Since Kolling deals with electronic statements which are financial documents, an ordinary skill artisan would have turned to the teachings of Krouse et al. for these above noted teachings. Krouse et al teach a system and method for scanning a financial document. Image manipulation, data extraction and indexing are performed. See column 14, lines 54-67 and column 10, lines 12-53 of Krouse et al. Krouse et al also disclose zone information for obtaining information from a financial document. See column 7, lines 33-67 of Krouse et al.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Krouse et al into the system of Kolling in order to facilitate the conversion of paper bills into an electronic format for presenting to a customer. The motivation would have been to encourage billers who are not yet ready to transmit electronic bills to the bill processors of Kolling to do so and also to facilitate the processing and/or conversion of paper bills to electronic bills.

As per claims 2 and 17 removing unnecessary material form the received paper bill is taught by Krouse et al. Kolling further teaches forwarding important documents from the received bill to the customer (see the abstract and column 4, lines 15-29); receiving a payment instruction form the customer to pay a bill, drafting a payment on an account for the customer account, and sending the payment to the biller that originated the bill (are taught on column 9, lines 13-28 of Kolling).

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As per claims 3, 18 and 26, the combination of Kolling and Krouse does not explicitly teach drafting a payment comprises the step of printing a physical check on the account. The Examiner notes that such is well known in the art the time of the filing of the invention. Incorporating such a feature in the combination of Kolling and Krouse would have been obvious to one of ordinary skill in the art do in order to provide alternate forms of payment in the combined system.

As per claims 4, 19 and 27, printing a stored scanned image of a remittance stub is not explicitly taught by Kolling. Krouse et al disclose storing a scanned image of a remittance stub. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Krouse et al into Kolling in order to store a scanned image of a remittance stub for record keeping, reconciliation and management of the combined financial system.

As per claims 5-6, 20-21, the combined teaching of Kolling and Krouse et al discloses drafting a payment comprising the step of submitting an electronic payment (see column 9, lines 14-48 of Kolling and the abstract of Krouse et al.) using one of an automated clearing house network, an automated teller machine network, and a credit card network

As per claims 7 and 22, the combined teachings of Kolling and Krouse et al. are discussed above. Krouse et al disclose extracting billing information from the electronic image using optical character recognition wherein the billing information is extracted using a predefined template for the type of bill identified and extracting an image of the payment remittance stub. See column 7, lines 50-67 of Krouse et al. Kolling also

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discloses a plurality of templates for customers' bills. Note column 10, line 49 to column 10, line 21 of Kolling.

As per claims 8 and 23, presenting an electronic image of a paper bill upon receipt of a request from the customer is taught by Kolling. See the abstract of Kolling.

Claims 9 and 25 contain features addressed in claim 1. Claims 9 and 25 are therefore rejected under a similar rationale as applied to claim 1 above.

As per claim 10, Kolling discloses a biller identification for identifying a particular bill. See column 10, lines 48-65 and column 9, lines 40-45 of Kolling.

As per claim 11, the combination of Kolling and Krouse does not explicitly teach drafting a payment comprises the step of printing a physical check on the account. The Examiner notes that such is well known in the art the time of the filing of the invention. Incorporating such a feature in the combination of Kolling and Krouse would have been obvious to one of ordinary skill in the art do in order to provide alternate forms of payment in the combined system.

As per claim 12, printing a stored scanned image of a remittance stub is not explicitly taught by Kolling. Krouse et al disclose storing a scanned image of a remittance stub. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Krouse et al into Kolling in order to store a scanned image of a remittance stub for record keeping, reconciliation and management of the combined financial system.

Each of claims 13 and 28 contains features recited in independent claims 1, 4, 5, 7 and 8, and therefore, appellant is directed to the rejection of claims 1, 4, 5, 7 and 8 above.

As per claims 14 and 29, see column 7, lines 54-62 of Krouse et al.

As per claims 15, 25 and 30, see column 7, lines 50-67 of Krouse et al.

(10) Response to Argument

Appellant argues that Krouse et al deals solely with payment and is completely incapable of presenting bill electronically.

In response, the Examiner has not applied the Krouse et al reference to denote teachings of presenting a bill electronically to a customer. The Krouse et al has been applied to denote teachings of scanning a paper document or bill were old, well known and practiced in the art at the time of the appellant's invention.

Appellant then argues that Kolling et al deal with the electronic statements and that one of ordinary skill in the art would not have turned to Krouse et al since there is no motivation in Kolling et al to do so.

In response, Kolling et al are directed to the presentment of electronic statements. In the system of Kolling et al, a plurality of different service providers electronically transmits electronic statements to a central location having a central computer. The central location then makes the electronic statements available to customers who have subscribed to receive online electronic bills or document. The process or functions of receiving, identifying and scanning a paper bill into an electronic

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form is not explicitly stated by Kolling et al. The Examiner had indicated that if a service provider is unable to submit their customers' billing information in an electronic form to the central location for subsequent presentment to their customers, the service provider would have then transmitted these billing information or bills in the form of "paper bill" via mail or fax.

Appellant has argued that there would be no motivation in Kolling et al to turn to Krouse et al because in Krouse et al, a customer has access to paper bills whereas Kolling et al prevents usage of paper billing.

In response, it should be noted that all bills in the system of Kolling et al are in electronic format. The central location of Kolling is not limited to accepting bills only in electronic forms. Thus, if a type of service providers is unable to transmit a customer's bill in electronic form to the central location, it would not have been practical or financially sound for the central location to miss the opportunity to perform business transactions with this type of service providers. Thus, the central location would have made it possible to accept paper bills and reformat them in electronic forms. In so doing, one of ordinary skill in the art would have turned to Krouse et al where it is taught functions of formatting a paper bill into an electronic form. Krouse et al teach a customer presents a paper bill to a point of sales so as to pay a current balance which is due. The paper bill is scanned and an electronic image of the paper bill is obtained for a permanent record. See column 4, lines 1-12, column 5, line 58 to column 6, line 14 of Krouse et al. Krouse et al also teach eliminating noise or cleaning the scanned

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image (column 13, lines 35-58); extracting information from the scanned image (column 16, lines 42-58) and generating an electronic image of the scanned document.

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Krouse et al into Kolling et al in order to allow the receipt of paper document so as to transform such into an electronic format to customers of service providers (which service providers being unable to handle electronic document for presentment to their remote customers). The motivation would have been to allow the central location to conduct business to service providers who do not have yet the capability of transmitting bills electronically to the central location.

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the owners of Kolling would not desire to avoid conducting business with service providers unable to transmit electronic bills.

One of ordinary skill in the art would have found it helpful to also accept paper bills and then transform them into electronic or digital form so as to make them available

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to remote customers and also to conduct business with service providers who are unable to transmit bills in electronic forms. Thus, the one of ordinary skill in the art would have turned to Krouse et al for the teachings of scanning and cleaning, extracting data from a scanned electronic bill and presenting the scanned bill in electronic form.

Appellant then argues that the Examiner had misinterpreted Krouse et al because in Krouse et al, a customer has a physical bill in his/her possession.

In response, the Examiner had applied Krouse et al to denote teachings of the conversion of a paper bill into an electronic or digital form not in the manner appellant is arguing.

Appellant then argues that while Kolling et al use the word template, it is used with a completely different meaning than that which is claimed and that in their system template implies "zone information for locating the required billing summary data".

In response, Krouse et al teach scanning a paper bill and extracting desired information from the scanned data bill. In extracting data from a scanned document, the Examiner had indicated that various functions would have been performed. The appellant disagrees and requests that the Examiner provides an affidavit or a reference. The Examiner again asserts that the location to detect the desired location or zone relevant to the desired information to be extracted from a scanned image must be known. This is a well-practiced step or function in the art. (See LeBrun et al , US Patent No. 5,191,525) at column 3, lines 37-40 and column 19, lines 58-67, column 5, lines 18-22 and column 3, lines 63-68).

As noted, Kolling et al accept bill data from a plurality of service providers wherein each service provider having a specific billing format. It is noted that Kolling et al provide a uniform billing statement and therefore would have used a template in order to generate the electronic bills from the plurality of service providers to present to the plurality of customers.

Appellant then argues that the combination of Kolling et al and Krouse et al does not teach means or a function of validating the extracted billing information. Appellant also stated that it appears that the Examiner has not in any way established an expertise in the field and the Examiner's rationale represents an unsupported and (unsupportable) modification of references which is inadequate to teach the invention as presently claimed.

In response, validating extracted information is taught by Krouse et al. (see column 15, lines 1-67 of Krouse et al). (Further support of such in the image processing art is also taught by Lebrun et al. See LeBrun et al at column 5, lines 35-64 and column 21, lines 30-45) for the obvious functions of validating extracted data to be present in the combination of Kolling et al and Krouse et al as such was well known in the art (or image processing) at the time of the appellant's invention. This function would have been necessary therein in order to ascertain that the scanned electronic data accurately reflects that of the paper document.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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